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Markus Hehli

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EXAMINER

WOODALL, NICHOLAS W

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/694,846
Filing Date: October 29, 2003
Appellant(s): HEHLI ET AL.

Oleg F. Kaplun
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07/01/2008 appealing from the Office action mailed 02/04/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 7, 9, 13, 14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmieding (U.S. Patent 5,626,613).

Regarding claim 1, Schmieding discloses a device having a longitudinal shape with a central axis, a first end, and a second end. The shape of the device is helical. Regarding claim 2, Schmieding discloses a device with an envelope of the helix is a cylinder having the same axis as the device. Regarding claim 7, Schmieding discloses a device wherein the cross-section orthogonal to the central axis of the helix is circular. Regarding claim 9, Schmieding discloses a device wherein the second end of the device is pointed. Regarding claim 13, Schmieding discloses a device wherein the portion nearest the first end of the device is thicker than the portion nearest the second end. Regarding claim 14, Schmieding discloses a device wherein the central axis of the helix is a straight line. Regarding claim 17, Schmieding discloses a device wherein the device is provided with through holes.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmieding (U.S. Patent 5,626,613).

Schmieding discloses the invention as claimed except for the cross-section orthogonal to the central axis having a squared, star, rectangular, or rectangular with rounded edges shape. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the cross-section orthogonal to the central axis of the device of Schmieding having a squared, star, rectangular, or rectangular with rounded edges shape, since appellant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a forming edge in the heating portion or clamp. In re Dailey and Eilers, 149 USPQ 47 (1966).

5. Claims 3-6, 11, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmieding (U.S. Patent 5,626,613).

Schmieding discloses the invention as claimed except for the helix having a rotation of less than 540 degrees, the radius of the cylinder is in the range of 10 to 50 mm, etc., it would have been obvious to one having ordinary skill in the art at the time

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the invention was made to construct the device of Schmieding with the helix having a rotation of less than 540 degrees, the radius of the cylinder being in the range of 10 to 50 mm, etc., since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmieding (U.S. Patent 5,626,613).

Schmieding discloses the invention as claimed except for the device having at least two through holes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Schmieding having at least two through holes, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

(10) Response to Argument

The appellant's argument that Schmieding does not disclose a device capable of being used as an intramedullary nail is not persuasive. The appellant argues that the term "intramedullary nail" defines specific structural qualities, i.e. the nail must be sized and shaped to conform to the medullary canal into which it will be inserted and the materials must be biocompatible and strong enough to absorb the stresses to which the bone will be exposed. The examiner disagrees with the appellant's interpretation of the term "intramedullary nail". The examiner believes that the term "intramedullary nail" defines the intended use of the device and does not impose any structural limitations

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other than the nail must be capable of fitting within, not conform to the medullary canal of a bone. The examiner believes that the device of Schmieding is fully capable of fitting within the medullary canal of a bone, such as a small bone of a larger organism or a large bone of a smaller organism. The device of Schmieding is made from a biocompatible material and is fully capable of absorbing at least some of the stresses applied to the bone. Therefore, the examiner believes the device of Schmieding discloses a device meeting the detailed interpretation of the term "intramedullary nail" as presented by the appellant. The appellant's argument that Schmieding does not disclose a "nail" is not persuasive. The appellant argues that Schmieding does not disclose a "nail" but a "screw" and therefore cannot be interpreted as an "intramedullary nail". The examiner disagrees with the appellant's argument that Schmieding does not disclose a "nail". A broad definition of the term "nail" is something resembling a nail in shape, sharpness, or use (www.dictionary.com). A broad definition of the term "screw" is a type of nail that is driven into something by a firm twisting action (www.dictionary.com). If the examiner were to agree with the appellant that the corkscrew device of Schmieding were a screw the definition of a screw clearly states a screw is a type of nail that is driven into something by twisting. Therefore, the Schmieding discloses a device that comprises a "nail". The appellant's argument that the device of Schmieding being used as an intramedullary nail if one so desired is unfounded is not persuasive. The appellant argues that the examiner's assertion that the device of Schmieding can be used as an intramedullary nail is based entirely on speculation, a misunderstanding of the meaning of the term "intramedullary nail", and a

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failure to consider or understand the function of the structure as indicated in the application and understood in the art. First, the examiner would like to note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, the examiner would like to note the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). The appellant’s argument that changing shape of the cross-section orthogonal to the longitudinal axis of the device would impede the function of the Schmieding device is not persuasive. The examiner does not believe that changing the shape of the cross-section to a square shape, a star shape, a rectangular shape, or a rounded rectangular shape would impede the function of the Schmieding device. The examiner believes that changing the shape of the cross-section would not destroy the function of the device and may even improve the function of the device by creating a larger surface area to contact the bone providing better fixation of the device within a bone. The appellant's argument that Schmieding does not disclose a motivation for changing the shape of the cross-section and therefore cannot be modified is not persuasive. The examiner would like to note that if Schmieding disclosed a motivation for changing the shape of the cross-section then the reference would anticipate the claimed subject matter under 35 U.S.C. 102, but since Schmieding does not disclose changing the shape of the cross-section the examiner has used established case-law

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stating that the modification would have been an obvious design choice to one having ordinary skill in the art. The appellant's argument that the examiner used hindsight reconstruction is not persuasive. The examiner would like to note, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, so long as the examiners judgment takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from the appellant's disclosure such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971). Furthermore, the examiner would like to note that the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale to modify may be expressly or implicitly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The appellant's argument that claims 3-6, 11, and 15-16 are allowable because Schmieding does not disclose a device disclosing the limitations of claim 1 is not persuasive. As discussed above, the examiner believes Schmieding discloses a device anticipating the limitations of claim 1 and believes the rejection of claims 3-6, 11, and 15-16 are still proper. The appellant's argument that claim 18 is allowable because Schmieding does not disclose a device disclosing the limitations of claim 1 is not persuasive. As discussed above, the examiner believes

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Schmieding discloses a device anticipating the limitations of claim 1 and believes the rejection of claims 3-6, 11, and 15-16 are still proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Nicholas Woodall/

Examiner, Art Unit 3733

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